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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.														
10/700,346	11/03/2003	Timo P. Tervo	NOKM.073PA	5267														
7590 Hollingsworth & Funk, LLC Suite 125 8009 34th Avenue South Minneapolis, MN 55425		10/04/2007	<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">KANG, PAUL H</td></tr><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>2144</td><td></td></tr><tr><td colspan="2"><table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>10/04/2007</td><td>PAPER</td></tr></table></td></tr></table>		EXAMINER		KANG, PAUL H		ART UNIT	PAPER NUMBER	2144		<table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>10/04/2007</td><td>PAPER</td></tr></table>		MAIL DATE	DELIVERY MODE	10/04/2007	PAPER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/700,346

Applicant(s)

TERVO ET AL.

Examiner

Paul H. Kang

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/8/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 28-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 28-34 recite a computer-readable medium. However, in the Specification a description of only a "computer-usable medium" or "any transmitting medium" is found (See Specification paragraphs 0065-0066). It appears that applicants intend the scope of "computer-readable medium" to encompass both "computer-usable medium" and "any transmission medium," including wireless/radio waves. Therefore, as carrier waves, transmission medium, etc. are nonstatutory subject matter, "computer-readable medium" as recited by the applicants are nonstatutory.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 8, 14-18, 20-25, 27-32 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Wireless Application Group, "User Agent Profile Specification", November 10,

1999 (hereinafter referred to as WAG).

4. As to claims 1, 14, 21 and 28, WAG teaches a method, system, mobile terminal and computer readable medium having instructions stored thereon executable by a computer for providing services usable by a mobile computing arrangement, comprising:

initiating a device startup sequence of the mobile computing arrangement (WAG, §§ 5.1-5.5, 6.1);

communicating a capability descriptor of the mobile computing arrangement to a service provider entity as part of the startup sequence (WAG, § 6.1);

selecting a data service targeted for the mobile device based on the capability descriptor communicated to the service provider (WAG, § 6.5); and

initiating the data service with the mobile computing arrangement (WAG, §§ 6.1-6.2, 6.5).

5. As to claim 2, WAG teaches the capability descriptor comprises a URL (WAG § 5.1).

6. As to claims 3, 15, 22 and 29, WAG teaches the URL references a User Agent Profile (UAProf) descriptor (WAG, §§ 5.1-5.5).

7. As to claims 4, 16, 23 and 30, WAG teaches the capability descriptor comprises a User Agent Profile descriptor (WAG, § 4.0).

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8. As to claims 5, 17, 24 and 31, WAG teaches the capability descriptor comprises a User Agent header (WAG, §§ 5.1, 6.1).

9. As to claims 6, 18, 25 and 32, WAG teaches the capability descriptor comprises a terminal model identifier (WAG, § 5.1).

10. As to claims 8, 20, 27 and 34, WAG teaches the method wherein communicating the capability descriptor of the mobile computing arrangement comprises communicating the capability descriptor to the services provider via a wireless network control channel associated with a network registration of the mobile computing arrangement (WAG, §§ 5.3-5.5, § 6).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 7, 9, 11, 19, 26 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over WAG in view of Skog et al., US Pat. App. No. 2004/0052233 A1.

13. As to claims 7 and 19, 26, WAG teaches the invention substantially as claimed. However, WAG does not explicitly teach communicating the capability descriptor of the mobile computing arrangement comprises communicating the capability descriptor targeted for the services

provider via Short Message Service (SMS). In the same field of endeavor, Skog teaches a system and method having profile and capability of WAP-terminal with external devices connected wherein communicating the capability descriptor of the mobile computing arrangement comprises communicating the capability descriptor targeted for the services provider via Short Message Service (SMS). (Skog, ¶0054). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated SMS into the WAP system of WAG since it is desirable to integrate multiple communication platform in order to enhance compatibility, accessibility and scalability.

14. As to claims 9, 11 and 33, WAG-Skog teach the method wherein communicating the capability descriptor of the mobile computing arrangement comprises communicating the capability descriptor targeted for the services provider via a secondary network interface of the mobile computing arrangement, wherein the secondary network interface of the mobile computing arrangement comprises a Bluetooth network interface (Skog, ¶¶ 0046-0050).

15. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wag-Skog in view of Acton, US Pat. App. No. 2003/0202016 A1.

16. As to claim 10, WAG-Skog teaches the invention substantially as claimed. However, WAG-Skog does not explicitly teach the method wherein the secondary network interface of the mobile computing arrangement comprises a wireless local area network (WLAN) interface. In the same field of endeavor, Acton teaches a system and method wherein the mobile computing

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arrangement comprises a wireless local area network (WLAN) interface (Acton, ¶0043). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the WLAN interface as taught by Acton into the system of WAG-Skog since the artisan has good reason to pursue the known options within his or her technical grasp.

17. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WAG in view of Open Mobile Alliance, "User Agent Profile", OMA-UAPProf-v2_0-20030520-C, May 20, 2003 (hereinafter referred to as OMA).

18. As to claim 12, WAG teaches the invention substantially as claimed. However, WAG does not explicitly teach the method further comprising communicating capabilities request targeted to the mobile computing arrangement, and wherein the capability descriptor targeted for the service provider entity is communicated in response to the capabilities request. In the same field of endeavor, OMA teaches the method further comprising communicating capabilities request targeted to the mobile computing arrangement, and wherein the capability descriptor targeted for the service provider entity is communicated in response to the capabilities request (See OMA, § 6.3.1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the client capability query in a push environment for the purpose of tailoring the content of messages generated.

19. As to claim 13, WAG-OMA teaches the method wherein the capabilities request is communicated via a Wireless Application Protocol (WAP) Over The Air (OTA) Push (OMA, §

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6.3.3).

Response to Arguments

20. Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection. The applicant argued in substance that as per claim 10, Coulombe does not qualify as prior art. Accordingly, Coulombe has been removed. Further, Applicant's arguments filed June 29, 2007 have been fully considered but they are not persuasive. Applicants argue in substance that the rejection of claims 1, 14, 21 and 28 is improper as WAG at least fails to expressly or inherently show a capability descriptor being communicated as part of a startup sequence." See Remarks, page 8, lines 18-20. The examiner respectfully disagrees.

It appears Applicants are arguing that "startup sequence" is more than merely initiating a session but more akin to a power up or boot sequence. Applicants argue limitations which are not essential to the scope of the prior art. The definiteness of the language employed must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Insofar, the claims have been given the broadest reasonable interpretation consistent with the specification and the prior art, since the applicant may then amend his claims, the thought being to reduce the possibility that after a patent is granted the claims may be interpreted as giving broader coverage than is justified. Therefore, applicant's arguments regarding "startup sequence" being more than establishing a session is not given weight as to the patentability of the claimed subject matter.

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As per Applicants' arguments regarding the remaining claims, Applicant relies on the argument set forth against claims 1, 14, 21, and 28, therefore they are not specifically treated here.

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H. Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul H. Kang/
Primary Examiner
AU 2144